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INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)



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Applicant's or agent's file reference P016023WO	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/GB 03/05592	International filing date (day/month/year) 22.12.2003	Priority date (day/month/year) 23.12.2002
International Patent Classification (IPC) or national classification and IPC H04Q7/22		
Applicant INTELLPROP LIMITED et al		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 8 sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising:
 - a. ☐ sent to the applicant and to the International Bureau) a total of sheets, as follows:
 - ☐ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
 - ☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.
 - b. ☐ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

Date of submission of the demand 18.06.2004	Date of completion of this report 17.03.2005
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Biyee, N Telephone No. +49 89 2399-2608 

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Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

Description, Pages

1-13 as originally filed

Claims, Numbers

1-34 received on 22.02.2005 with letter of 22.02.2005

Drawings, Sheets

1/1 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing
3. ☒ The amendments have resulted in the cancellation of:
- ☐ the description, pages
 - ☒ the claims, Nos. 35,36
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):

* If item 4 applies, some or all of these sheets may be marked "superseded."

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Box No. II Priority

1. ☐ This report has been established as if no priority had been claimed due to the failure to furnish within the prescribed time limit the requested:
 - ☐ copy of the earlier application whose priority has been claimed (Rule 66.7(a)).
 - ☐ translation of the earlier application whose priority has been claimed (Rule 66.7(b)).
2. ☐ This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rule 64.1). Thus for the purposes of this report, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:
see separate sheet

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	8-15,24-31
	No: Claims	1-7,16-23,32-34
Inventive step (IS)	Yes: Claims	10-15,27-31
	No: Claims	1-9,16-26,32-24
Industrial applicability (IA)	Yes: Claims	1-34
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

A. Citations and explanations made in respect of paragraph V:

Reference is made to the following documents:

D1: WO 00/54488 A1

D2: WO 01/99341 A1

D3: US 2002/0112014 A1

1. Notwithstanding the lack of clarity mentioned on paragraph C. below, the subject-matter of claim 1 is not new in the sense of Article 33 (2) PCT, the reasons being as following:
 - 1.1 Document **D2** (see in particular page 3, line 5 to page 5, line 28; page 6, line 8 to page 9, line 19; page 10, line 24 to page 12, line 21; page 13, lines 1 to 5) discloses, according to **all** the features of **claim 1** (references in parentheses relate to citations from document **D1**), a telecommunications services apparatus for use with a mobile telephone network utilising a first message delivery function (see in particular page 2, lines 1 to 3; page 7, lines 29 to 30), the apparatus comprising routing means for identifying a characteristic in a message signal received in the telephone network (see in particular page 2, lines 6 to 7; page 4, lines 6 to 10; page 7, lines 23 to 25), and message processing means for translating a short form destination address in the message signal into a full destination address (see in particular page 2, lines 1 to 3; page 8, line 26 to 31; page 9, lines 7 to 9 and lines 13 to 15) for a second message delivery function (see in particular page 2, lines 1 to 3; page 9, lines 15 to 18), the address translation being effected using a predefined syntax (see in particular page 4, lines 10 to 13; page 6, lines 7 to 11; page 12, lines 11 to 12), and the routing means being operable to send the message signal to the message processing means in response to identification of the characteristic in the message signal (see in particular page 3, lines 7 to 10 and lines 13 to 19; page 7, lines 7 to 10), wherein the characteristic in the message signal to be identified by the routing means is when the destination address is in alphanumeric form (see in particular page 5, lines 22 to 25; page 6, lines 7 to 11; page 9, lines 18 to 19; page 12, lines 11 to 12), and wherein the alphanumeric destination address is carried within an SMS destination address field (see in particular "SMS" on page 1, lines 10 to 14; page 3, line 19; page 8, lines 28 to 30; page 9, lines 18 to 19).

The subject-matter of claim 1 therefore is **not new**, Article 33 (2) PCT.

- 1.2 Document **D3** also discloses **all** the features of **claim 1** (see in particular page 2, paragraph [0030] to page 3, paragraph [0032]; page 4, paragraph [0049] to page 5, paragraph [0062]; page 7, paragraphs [0080], [0085] to [0090]; page 8, paragraphs [0091] to [0097], paragraph [0101] and paragraph [0102], lines 1 to 7; page 9, paragraphs [0110] to [0114]; page 10, paragraph [0117], lines 1 to 4; page 11, paragraphs [0127] to [0129] and paragraph [0132] to page 12, paragraph [0146]; page 13, paragraphs [0151] to [0157]; page 14, paragraph [0172] to page 15, paragraph [0182], lines 1 to 6).

Therefore, document **D3** is prejudicial to the novelty (Art. 33 (2) PCT) of claim 1.

2. Inventive step, Article 33 (2) PCT:

- 2.1 It should furthermore be noted that even if the Applicant intended to argue **novelty** of **claim 1** based on a slightly different interpretation of the features of said claim and those disclosed in document **D2** or in document **D3** (see respectively paragraphs 1.1 and 1.2 above), the subject-matter of claim 1 **would not involve an inventive step**, Article 33 (3) PCT, having regard to the disclosure of said documents and the normal knowledge of a person skilled in the art of text messages routing using short/full addressing methods in radio communication networks.
- 2.2 Document **D1** (see in particular abstract; page 5, line 5 to page 9, line 23; page 11, lines 1 to 27; page 12, line 5 to page 15, line 16; page 16, line 23 to page 20, line 29; page 23, line 19 to page 24, line 18) discloses, according to the **main** features of **claim 1** (references in parentheses relate to citations from document **D1**), a telecommunications services apparatus for use with a mobile telephone network (see in particular page 5, lines 5 to 27) utilising a first message delivery function (see in particular page 11, line 9), the apparatus comprising routing means for identifying a characteristic in a message signal received in the telephone network (see in particular page 16, line 23 to page 17, line 5), and message processing means for translating a short form destination address in the message signal into a full destination address (see in particular page 6, lines 15 to 23 and line 31 to page 8, line 15; page 13, lines

3 to 14 and lines 24 to 27; page 14, lines 1 to 7; page 23, line 19 to page 24, line 18) for a second message delivery function (see in particular page 5, lines 5 to 13; page 11, line 10; page 15, lines 14 to 21), the address translation being effected using a predefined syntax (see in particular page 6, line 21 to page 7, line 25; page 23, lines 20 to 25; page 24, lines 14 to 16), and the routing means being operable to send the message signal to the message processing means in response to identification of the characteristic in the message signal (see in particular page 16, line 32 to page 17, line 12), wherein the characteristic in the message signal to be identified by the routing means is when the destination address is in alphanumeric form (see in particular page 6, line 21 to page 7, line 25; page 23, lines 20 to 25; page 25, lines 6 to 7), and wherein the alphanumeric destination address is carried within an **E-mail** destination address field (see in particular page 5, lines 5 to 13; page 24, lines 30 to 32).

The subject-matter of **claim 1** differs from that disclosed in document **D1** merely in that the alphanumeric destination address is carried within an **SMS** destination address field.

However, this distinguishing feature (destination address carried within an **SMS** destination address field, i.e. use of SMS to transmit text message) do not add anything of inventive significance to claim 1 as said feature, which is implicitly disclosed in document **D1** (see in particular page 5, lines 7 to 13), represents merely one of several straightforward possibilities from which the skilled person would select, in accordance with circumstances, without the exercise of inventive skill, in order to transmit text message in a mobile telephone network (see eg. document **D2** or **D3** which disclose similar methods).

The subject-matter of claim 1 therefore does not involve an inventive step in the sense of Article 33(3) PCT.

3. The same considerations as made above in paragraphs 1. and 2., regarding respectively novelty (Article 33 (2) PCT) and inventive step (Article 33 (2) PCT) of claim 1, are also valid for **independent claims 17, 33 and 34** since said claims are based on the same features combination as claim 1 in terms of a telecommunications

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services method (claim 17), a computer program for implementing said method (claim 33) and a storage medium storing said computer program (claim 34).

Therefore independent claims 17, 33 and 34 are **not allowable**, Article 33 (1) PCT.

4. Dependent claims

- 4.1 The **dependent claims 2 to 9 and 16, 18 to 25 and 32** do not contain any additional features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT with respect to novelty **and/or** inventive step, Article 33 (2)- (3) PCT, because said features are respectively either directly derivable from the disclosure of document **D1 and/or** document **D2** (see citations on paragraphs 2.2 and 1.1 above), **or** represent merely normal and well-known design details.

Dependent claims 2 to 9 and 16, 18 to 25 and 32 do **not** meet the requirements of Article 33 (1) PCT.

- 4.2 The additional features of **claims 10 to 15 and 27 to 31** are neither disclosed, suggested, nor rendered obvious by the available prior art documents.

Therefore, dependent claims 10 to 15 and 27 to 31 appear novel (Article 33 (2) PCT) and inventive (Article 33 (3) PCT).

B. Additional remarks concerning the form and contents of the application:

1. The documents **D1 and D2** are not identified in the description and the relevant background art disclosed therein is not briefly discussed, Rule 5.1 (a) (ii) PCT.
2. The opening part of the description is not in conformity with the claims as required by Rule 5.1(a)(iii) PCT.
3. The independent claims are not properly casted in the two-part form with those features which in combination are part of the nearest prior art being placed in the

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preamble, Rule 6.3 (b) PCT.

4. The features of the claims are not provided with reference signs placed in parentheses to increase the intelligibility of the claims (Rule 29(7) EPC). This applies to both the preamble and characterising portion (see the Guidelines, C-III, 4.11).

C. Additional remarks concerning the clarity of the claims, description and drawings:

The wording "is when" in the statement "...the characteristic in the message signal to be identified...is when the destination address is in alphanumeric..." in claim 1 and independent claim 17 is unclear and leaves the reader in doubt as to the meaning of the technical features to which it refers, thereby rendering the definition of the subject-matter of said claims unclear (Article 6 PCT).

D. Additional remarks concerning paragraph II. Priority:

It has not been possible to consider the validity of the priority claim due to the failure to furnish the requested copy of the earlier application whose priority has been claimed (Rule 66.7(a)). This report has nevertheless been established on the assumption that the priority is valid.

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